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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,015	04/22/2005	Bernhard Banowski	HM/5.22840/A/HEK 2/PCT	8747
324	7590	06/29/2006	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			KIM, VICKIE Y	
		ART UNIT		PAPER NUMBER
		1618		
DATE MAILED: 06/29/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/511,015	BANOWSKI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Vickie Kim	1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 6 and 8-119 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 6,8 -11 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

1. Acknowledgement is made of amendment filed 3/16/2006. Upon entering the amendment, the claims 6, 8-9 are amended and the claims 7-8 are canceled.

New claims 10-11 are added.

2. The claims 6, 8(?)11 are pending and presented for the examination.

### ***Response to Arguments***

1. New matter rejection is withdrawn hereinafter in view of amendment filed 3/16/2006.

2. Applicant's arguments with respect to claims 6-9(102 rejection) have been considered but not persuasive.

***Due to the amendment with scope changes, the rejection included in previous office action is modified. However, they are based on same prior art and the rejection is essentially same.***

### ***Claim Objections***

1. Claim 8 is objected to because of the following informalities: Claim 8 has been amended 3/16/2006(see page 2). However, claim 8 is also requested for cancellation in same amendment filed 3/16/2006(see page 2). Clarification is required.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S.C 102 not included in this action can be found in a prior Office action.

4. Claims 6, 10-11 are rejected under 35 U.S.C. 102(b) or (e) as being anticipated by Holzl et al(EP 1053989) or Holzl(US2003/0162836 or US2004/0186174).

Note: For convenience, US2003/0162836 has been cited hereinafter and represent all three Holz references mentioned above.

The claim is drawn to a method of inhibition of arylsulfatase using effective amount hydroxydiphenyl ether substance having general formulas as recited in instant claims 6 and 10.

Holzl et al(US836, hereinafter) teaches a hydroxydiphenyl ether compounds as antimicrobially active substances in the preparation of deodorants or antiperspirants where antimicrobial activity against various gram positive organisms such as *S.aureus*, *S. epidermidis*, or *S.hominis*, see abstract and page 29(table 4).

As to the instant claims, US836 clearly teaches that antimicrobial activity is responsible for deodorizing action and furthermore, US836 uses substantially same hydroxydiphenyl ether compounds which is also required by instant claims, see paragraph 4-16.

US836 contemplates deodorant sprays, gels, sticks or roll-ons, see paragraph 154 at page 9.

At that time of the invention was filed, inhibition of bacterial exoenzymes arylsulfatase which is an underlying mechanism responsible for achieving deodorant activity is well known by skilled artisan, see supporting document(US5643559(Eigen et al , issue date: July 1997, col.1, lines 10-15, enclosed in PTO-892). Especially, US559

teaches *S. epidermidis* as main causative organism responsible for producing body ordor, see col 2, lines 20-25.

One would have been envisaged that deordorant containing hydroxydiphenyl ether compounds taught in Holz(US'836) utilizes antimicrobial action against *S. Epidermidis* which results in arylsufatase inhibitory action, where the body ordors has been reduced.

The claimed subject matter is not patentably distinct over the prior art of the record because arylsulfatase inhibition is inherent feature which is naturally possessed by teaching of Holz Patents(application of deordorant containing hydroxydiphenyl ether compounds). Since the inhibition of arylsulfatase has been already known at the time of the invention filed, regardless of the explicit discussion of said underlying mechanism, one skilled artisan readily understood and envisioned arylsulfatase inhibition obtained by application of hydroxydiphenyl ether compounds.

***Claim Rejections - 35 USC § 102/103***

5. Claims 8-9 are rejected under 35 U.S.C. 102(b/e) as being anticipated by, or alternatively obvious over Holzl et al((EP 1053989; US2003/0162836; or US2004/0186174) alone, or alternatively OTC products(secret™ or speedstick™).

Holz(US'836) teaches that deodorants available in various formulation such as sprays, gels, sticks or roll-ons, see paragraph 154 at page 9.

As mentioned in US836 also teaches that personal care products are prepared customary methods based on individual's needs.

As to claims 8-9, claims require product with gender specifically in respect of the amount and/or nature(e.g.product for men).

However, it would have been obvious to one of ordinary skill in the art at that time of the invention was made have been obvious to any ordinary skill in the art to manufacture gender specific product because man usually have heavy daily activity which produce more sweat and require heavy protection for ordor, whereas woman in common, has lighter daily activity which require less protection and thus, less active ingredients required. As evidenced by the product in market place(e.g. Speed Stick® vs Lady Speed Stick®) are already well known and available as Over the counter products in the market place and industries. Because of the difference in amount of sweats and personal activities where the men vs. women require different level of protection. For example, the OTC(over-the –count) deodorants or antiperspirants are available in gender based products, and thus gender oriented product is readily envisioned by or apparent to any ordinary skilled artisan so that the benefit from using gender oriented product can be maximized.

The claims are either anticipated because the limitations are clearly envisioned by Holz's teaching itself, in alternative the claims are obvious over the Holz's teaching in view of conventionally known products(Right-Gard® or Speed Stic™ for man or Lady Speed stic ® soft & Dri™ for woman ) available in market place.

One would have been motivated to do so, with reasonable expectation of success because it is always desirable to improve patient's compliance and user satisfaction so that industrial applicability is increased. The techniques and skills

required for making such substitution is conventional knowledge or well within the skills of ordinary artisan as evidenced by cited references.

One would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities, and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

#### Conclusion

6. No claim is allowed. Having carefully reviewed applicants' Request for Reconsideration, the examiner maintained the rejection in any respect.

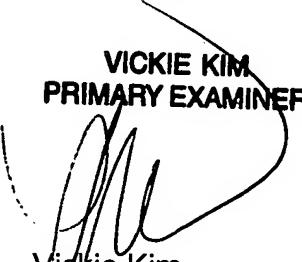
1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
VICKIE KIM  
PRIMARY EXAMINER

Vickie Kim  
Primary Patent Examiner  
June 23, 2006  
Art unit 1618